

Remarks

Claims 1-15 are pending in the above-identified application. Claims 1, 7, and 12 are amended, and claims 2-6, 8-11 and 13-15 is original.

The Examiner rejected the present claims under 35 U.S.C. 103(a).

MPEP §706.02(j) states:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP §2143.01 provides: The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

One court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." *Id.* at 1357, 47 USPQ2d at 1458. Here, according to this court, the Board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination.

The Examiner rejected claims 1-2 & 7 under 35 U.S.C. 103(a) as being unpatentable over Kotzin [US 20040198-560] in view of La Medica, Jr. et al. [US 6625451].

The Examiner alleged that as per claim 1, Kotzin teaches: a method for selecting, by a mobile terminal, (10; Fig. 1) a roaming service provider in a telecommunications network, when the mobile terminal is roaming, (Abstract) the method comprising the steps of: communicating between a mobile terminal and current roaming service providers for a current location of the mobile terminal; (i.e. monitor service...network parameters; 0021; Pg.2); selecting, based on the roaming service provider information, a respective one of the current roaming service providers; (i.e. subscriber...information... communication; 0022; Pg.2); and connecting subsequent call(s) associated with the mobile terminal using the selected respective roaming service provider. (i.e. engage communication; 0028; Pg.3 and Claim 1).

The Examiner admitted that Kotzin doesn't teach explicitly, detecting registration message from the mobile terminal. However, the Examiner then alleged that La Medica teaches in an analogous art, providing to the mobile terminal, at least upon detecting registration message from the mobile terminal, respective roaming service provider information associated with the

current roaming service providers; (i.e. attempt ... register; Col. 18; 65-Col. 19; 9). The Examiner then concluded that it would have been obvious to one of ordinary skill in the art at the time of invention to include detecting registration message from the mobile terminal in order to provide user selectable modes of operation in a mobile communication station, which allow certain fall-back options when a preferred system may not be available, but still steers the bulk of the system selection operations to preferred systems.

With this amendment applicant has amended each of the independent claims 1, 7 and 12 to more clearly define Applicant's invention. In particular, in claim 1 for example, the method has the steps of: registering, by the mobile terminal, with each of the current roaming service providers; and receiving, by the mobile terminal, respective roaming service provider information from each of the current roaming service providers in response to the registration.

Kotzin teaches selection of a service provider network at a wireless subscriber device (10) that includes monitoring service provider network parameters (54) of each of a plurality of available service provider networks (S1, S2), predicting performance capabilities of each of the plurality of available service provider networks (S1, S2), computing a performance metric (56) for each of the plurality of available service provider networks (S1, S2) based on desired performance parameters and on the predicting of performance capabilities of each of the plurality of available service provider networks (S1, S2), and selecting one of the plurality of available service provider networks (S1, S2) based on the computed performance metric (58). The subscriber device (10) is therefore capable of rapidly and autonomously identifying a service provider network that would best serve its current service needs based on the performance metric.

The Examiner has admitted that Kotzin doesn't teach explicitly, detecting a registration message from the mobile terminal. Since Kotzin does not teach detecting the registration message, this precludes the step of: receiving, by the mobile terminal, respective roaming service provider information from each of the current roaming service providers in response to the registration.

The Examiner has cited La Medica as teaching; providing to the mobile terminal, at least upon detecting registration message from the mobile terminal, respective roaming service provider information associated with the current roaming service providers (i.e. attempt ... register; Col. 18; 65-Col. 19; 9). In this paragraph La Medica teaches as follows:

"FIG. 6 is a flow chart illustrating the system selection routine of a station programmed to implement a preferred embodiment of the system selection procedures described above. Essentially, the station will cycle through this routine as it attempts to find and register with a system. The box in the top right corner of the drawing illustrates the display of the system selection options. The flow chart to the left illustrates the process flow, and the dotted line arrows between options shown the box and the flow chart indicate the association of certain process steps with the particular system selection modes set by the user."

However, La Medica does not teach registering, by the mobile terminal, with each of the current roaming service providers; and then receiving, by the mobile terminal, respective roaming service provider information from each of the current roaming service providers in response to the registration. In column 15, lines 53, 54 La Medica discloses that the subscriber station 3 maintains a stored list of "preferred" systems, as a preferred roaming list (PRL).

Also, in column 16, lines 5-12, La Medica teaches that the service provider stores an initial version of the PRL list in memory in the station 3, at the time of service activation. Again, the preferred approach is to download this list over-the-air at service activation. As the service provider's business arrangements change over time, the provider utilizes the same procedure to periodically download a new updated version of the PRL list, as a replacement for the previous version stored in the station.

The present invention as claimed does not require or use such a PRL list that must be stored in the mobile terminal. Thus no combination of Kotzin and La Medica teach the present invention as claimed in independent claim 1.

Claim 2 is a dependent claim that include all the limitations of independent claim 1 upon which it depends, and is therefore allowable over the cited prior art.

Independent claim 7 as amended is patentable over any combination of the cited prior art for the reasons set forth above with respect to independent claim 1. Claim 7 has been amended to include: registering, by the mobile terminal, with each of the current roaming service providers; and receiving, by the mobile terminal, respective roaming service provider information from each of the current roaming service providers in response to the registration.

The Examiner rejected claims 3-4, 8 & 11 under 35 U.S.C. 103(a) as being unpatentable over Kotzin & La Medica further in view of Rosenberg [US 20020102973].

Claims 3-4, 8 & 11 are dependent claims that include all the limitations of the respective independent claims upon which they depend, and are therefore also allowable over the cited prior art for the reasons set forth above with respect to independent claim 1.

The Examiner rejected claims 5, 9, 12 & 14 under 35 U.S.C. 103(a) as being unpatentable over Kotzin & La Medica further in view of Nelson [US 6470182].

Independent claim 12 as amended is patentable over any combination of the cited prior art for the reasons set forth above with respect to independent claim 1. Claim 12 has been amended as follows: wherein, each current roaming service provider, upon detecting the a respective registration message from the mobile terminal, sending, in response to the registration respective roaming service provider information that is associated with each of the current roaming service providers ~~is provided~~ to the mobile terminal and displayed.

Claims 3-4, 8 & 11 are dependent claims that include all the limitations of the respective independent claims upon which they depend, and are therefore also allowable over the cited prior art for the reasons set forth above with respect to independent claim 1.

The Examiner rejected claims 6 & 10 under 35 U.S.C. 103(a) as being unpatentable over Kotzin & La Medica further in view of Moore [US 20050020293].

Claims 6 & 10 are dependent claims that include all the limitations of the respective independent claims upon which they depend, and are therefore also allowable over the cited prior art for the reasons set forth above with respect to independent claim 1.

The Examiner rejected claim 13 under 35 U.S.C. 103(a) as being unpatentable over Kotzin & La Medica, Nelson further in view of Rosenberg.

Claim 13 is a dependent claim that include all the limitations of independent claim 12 upon which it depends, and is therefore allowable over the cited prior art.

The Examiner rejected claim 15 under 35 U.S.C. 103(a) as being unpatentable over Kotzin & La Medica, Nelson further in view of Moore.

Claim 15 is a dependent claim that include all the limitations of independent claim 12 upon which it depends, and is therefore allowable over the cited prior art.

None of the cited prior art of Kotzin, La Medica, Nelson, Moore and/or Rosenberg disclose the novel features of the claims as set forth above.

The prima facie case of obviousness determination has not been made out. Thus, the opinion of obviousness is deficient and the Applicants are deserving of a patent.

Applicants respectfully submit that the applied references, taken singly or in combination, assuming, arguendo, that the combination of the applied references is proper, do not teach or suggest one or more elements of the claimed invention. Applicants have discussed herein one or more differences between the cited prior art, and the claimed invention with reference to one or more parts of the cited prior art. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of cited prior art correspond to the claimed invention.

Reconsideration and withdrawal of the rejections is therefore respectfully requested. In view of the above remarks, allowance of all claims pending is respectfully requested.

The prior art made of record and not relied upon is considered to be of general interest only. This application is believed to be in condition for allowance, and such action at an early date is earnestly solicited. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicant's attorney.

Respectfully submitted,



John R. Garrett
Attorney for Applicant
Reg. No. 27,888

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CARMEN B. PATTI & ASSOCIATES, LLC
Customer Number 47382